

# Notice of Allowability

Application No.

10/725,638

Examiner

Stacy A. Whitmore

Applicant(s)

VOGEL ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to election and canceled claims in examiner's amendment dated 12/8/2006.
2. ☒ The allowed claim(s) is/are 20-31, renumbered as 1-12.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 12/2/2003
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

Detailed Action

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to a customizable development and demonstration platform for structured ASICs, comprising a structured ASIC, and FPGA coupled to said ASIC, wherein a SERDES port is driven by a test block, classified in class 716, subclass 16.
  - II. Claims 16-19, drawn to a customizable development and demonstration platform for structured ASICs, comprising a structured ASIC, wherein a SERDES port is driven by a test block, classified in class 716, subclass 16.
  - III. Claims 20-31, drawn to a customizable development and demonstration platform for structured ASICs, comprising a structured ASIC, and FPGA coupled to said ASIC, wherein a SERDES port is driven by a test block to run signal integrity tests, and to show characteristics of IP, and a SERDES port is pinned out to a link layer in the FPGA, classified in class 716, subclass 16.

2. The inventions are distinct, each from the other because of the following reasons:  
Inventions I, II, and III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the platform as claimed in claims 1, 16, and 20 are geared towards different combinations of sub-elements of that claimed in claim 20 (Group III) that do not require elements as disclosed in the groups I and II. The subcombination has separate utility such as

different structures or methods of using different structures for customizing a development and demonstration platform for a structured ASIC.

3. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Chad Swantz on December 8, 2006, a provisional election was made without traverse to prosecute the invention of Group III, claims 20-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

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by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Chad Swantz on December 8, 2006.

The application has been amended as follows:

In the claims:

I. **Cancel claims 1-19.**

7. Claims 20-31 are allowed over the prior art of record.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose either singularly or in combination the invention as claimed, including a customizable development and demonstration platform for structured ASICs, comprising: a structured ASIC built on a slice and FPGA, and SERDES ports ; wherein one of said a plurality of high speed SERDES ports is driven by a test block in said structured ASIC to run signal integrity tests and to show electrical characteristics of intellectual property of said a plurality of high speed SERDES ports, and at least one of said a plurality of high speed SERDES port is pinned out to be driven from a link layer realized in said FPGA.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy A. Whitmore whose telephone number is (571) 272-1685. The examiner can normally be reached on Monday-Thursday, alternate Friday 6:30am - 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Chiang can be reached on (571) 272-7483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stacy A Whitmore

Primary Examiner

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SAW

December 8, 2006

A handwritten signature in black ink, appearing to read 'Stacy A. Whitmore', is written over the printed name and title.